

Application No. 10/022,668
Docket No. 2001U013.US
Reply to Office Action Dated July 27, 2004

Remarks

Section 102 Rejections

Claims 1-9 and 11-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Imuta et al* (EP 0 893 454 A1). The Applicant traverses this rejection, as the Applicant's claimed invention cannot be "at once envisaged" by one skilled in the art, and thus anticipated, by the prior art. This is because Applicant claims a small subgenus ("specie")—unsymmetrically substituted ligands wherein R and R' are distinct from one another—wherein the '454 is primarily directed to compounds that are symmetrically substituted.

In particular, the Applicant contends that the present invention is not disclosed by the '454 patent. The MPEP states in this regard the following:

When the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. MPEP § 2131.02 (Rev. 2, May 2004) (citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990)).

Applying this point of law to Applicant's claimed invention, the "compound" and "specific composition" described in the quote above are analogous to Applicant's claimed "catalyst precursor composition"; and the "reference" is of course the '454 publication. In the present situation, the claimed "catalyst precursor composition" is a small subgenus (or "specie") of the much larger genus disclosed in '454.

In only four locations in the lengthy '454 disclosure can one find a reference to permutations of structures that might be non-symmetrical. At page 10, line 55, for example, it states that "R¹ groups may be the same or different from each other", yet the remainder of the disclosure and the specific embodiments at pages 13-19 are directed to

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symmetrical species. The same is true of the corresponding statement for the corresponding embodiments at page 29, line 27; page 40 line 27; and page 58 line 54.

Applicant contends that the current situation is similar to that treated by the court in *In re Meyer*, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979), wherein the prior art reference in that situation discloses a large genus, and the claimed invention was to a narrow subgenus ("species"); and in *Akzo N.V. v. International Traded Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986), wherein there was a broad disclosure in the prior art to using sulfuric acid in a process, but not the specific disclosure, i.e., subgenus, of using a "at least 98% solution" of sulfuric acid.

In particular, the court in *In re Meyer* stated:

The genus, "alkaline chlorine or bromine solution," does not identically disclose or describe, within the meaning of § 102, the species alkali metal hypochlorite, since the genus would include an untold number of species. *In re Meyer* at 1031.

The court in *Akzo* stated that:

we understand that opinion [of the International Trade Commission] as simply finding that the prior art reference did not disclose, to one of ordinary skill in the art, the process for making the aramid fibers described in claim 13. The Commission noted that while the Morgan '645 patent called for the use of sulfuric acid, it did not call for the use of at least 98% concentrated sulfuric acid which was critical for the success of the Blades process. The Commission also concurred with the ALJ and found that concentrated sulfuric acid is not inherently 98% sulfuric acid to one skilled in the art. *Akzo* at 1479.

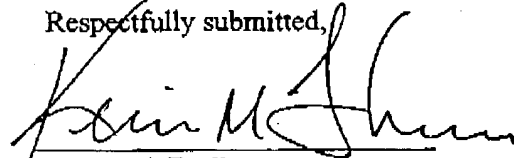
In both cases the court found the claims allowable over the art at issue. Applicant contends the same would hold true here and that, therefore, the Examiner should withdraw this rejection.

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The Applicant thus requests the withdrawal of the rejection in this case. The Applicant invites the Examiner to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Examiner's satisfaction.

8/13/04
Date

Respectfully submitted,


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